



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/420,991	10/20/1999	JONATHAN KEPECS	18477-000120	3518

7590

07/14/2004

GARY T AKA
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO, CA 941113834

EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/420,991

Applicant(s)

KEPEC

Examiner

JAGDISH PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25,29-31,33-41,59-76,80-82 and 84-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25,29-31,33-41,59-76,80-82 and 84-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3624

DETAILED ACTION

1. This communication is in response to amendment after final filed 18 May 2004

Response to Amendment and Remarks

2. Claims 1, 29-31, 32, 59 and 8-84 have been amended and claims 26-28, 32, 42-58, 77-79 and 83 have been cancelled per request. Currently claims 1-25,29-31,33-41,59-76,80-82 and 84-89 are pending.

3. Upon further consideration, the claims indicated as allowable over prior art have been found deficient as further explained in the following paragraphs. In particular, the new limitation in the claim (those from dependent claims deemed allowable) are not functionally related to the process steps of the (original) claim 1. The amendment of the claim therefore does not further distinguish the claimed invention from the cited prior art.

It should also be noted that the limitation "maintaining an account" is also deemed deficient for the similar reason, namely the properties or attributes of the account have no functional relationship to the remaining method steps.

4. In view of the new ground of rejection which is not necessitated by the applicant's amendment, the finality of prior action is withdrawn.

Statute Cited in Prior Action

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

6. Claims 1-25, 29-31, 33-41, 59-76, 80-82 and 84-89 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and dependent claims recite limitation "maintaining an account for each consumer.." which further recites that the account has the attributes of "a limited direct identification of said consumer with said account to exclude identification of said consumer by name". Claim 1 further limits the maintaining step as comprising a database of only said key, at least one financial institutional account number, and purchasing history for each consumer".

The claim is indefinite because:

The claim is silent in regard to any utility of the limited direct identification of the consumer in the subsequent method steps.

The claim is also silent in regard to any utility of having a database which has only certain elements. Furthermore, the

Art Unit: 3624

nowhere in the claim the financial institution account number and the purchasing history for each consumer is required.

This analysis also relates to independent claim 59 and dependent claims.

Claims 33 and 84: limitation "said credit" lack antecedent basis. This limitation require a credit amount be distinctly claimed (such as determining a credit amount to be credited to the financial institutional account). There is no such limitation in the claim.

Claim Rejections - 35 USC § 103

7. Claims 1-25,29-31,33-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Day et al. (US Pat. 5,857,175) (Day) and further in view of Nichtberger et al (US Pat. 4,882,675) (Nichtberger).

Claim 1: Day recites method for distributing and redeeming electronic promotions to a plurality of consumers through a communications network, comprising:

Maintaining an account for each consumer, said account having a limited direct identification of said consumer with said account to exclude identification of said consumer by name (customer account for each customer are identified by card 22 which contain UPC Codes, col. 5 L 10-29, members of a household

Art Unit: 3624

can be treated as a single customer...all have cards associating them with same customer account, col. 6 L 58-62);

(in particular, the examiner notes that the recited attributes of the account has no bearing on the subsequent limitations)

associating each consumer account with a unique key (see discussion of maintaining step);

permitting access to said consumer account upon presentation of said unique key over said communications network (means for accessing information about the special offers available to the customer associated with the card, col. 5 L 25-29);

presenting promotion choices of items available at least one store associated with said unique key over said communications network (refer to: special offers available to the customer...sends a list of special offers to offer communicator 32, col. 5 L 28-33) ;

receiving data of purchased items are received at said associated store (col. 6 L 13-49, data of purchased items are received at the check-out 34 as discussed) .

Day invention does not teach the recording selections of promotional choices AND reconciling said selections and purchases to credit said consumer made by consumer as claimed.

In the same field of endeavor, however, Nichtberger teaches a method of distributing and redeeming and clearing electronic promotions. Nichtberger teaches:

Art Unit: 3624

recording selections of said promotion choices made by said consumer over said communications network (col. 5 L 11-15, customer then selects the coupons which he or she wishes to redeem);

reconciling said selections and purchases to credit said consumer (col. 5 L 17-25, the attendant causes the card to be read..the checkout system then automatically credit the consumer for the coupons the consumer has selected).

It would have been obvious to ordinary skill in the art at the time of the invention modify Day so that the consumer is enabled to makes selections of the promotions from the presented promotion choices, and subsequently reconciling the selections against the purchases made by the consumer as per Nichtberger because the combined method would be more convenient to the consumer as she would have to carry any list of special offers while shopping as the consumer has already pre-selected those promotions available to her and would be assured that he or she will be automatically credited for if corresponding items are purchased.

Day and Nichtberger further fail to expressly show that the maintaining of consumer account step comprises maintaining a database of only said key, at least one financial account number, and purchasing history for each consumer.

Art Unit: 3624

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The associating each consumer account, permitting access, presenting promotional choices, recording selections, receiving data of purchase items, and reconciling said selections and purchases steps would be performed the same regardless of the maintaining step (database of only said key, at least one financial institutional account number..) because the database maintained in the manner recited is not required for execution of any of the aforementioned steps. (note: the associating step inherently relates each consumer with a unique key and therefore a has database that correlates each consumer with a respective key.) Thus, this descriptive material will not further distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to maintain a database for a consumer having any attributes of the consumer including the elements recited in the maintaining an

Art Unit: 3624

account step of the instant claim because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claims 29-31 are similarly analyzed since they further limit the financial institutional account.

Claim 2 : The method of claim 1 wherein said reconciling step comprises recording a credit in said consumer account (Day col. 6 L 30-34, "check-out applies any special offers available to that customer..").

Claim 3. The method of claim 2 wherein said consumer account comprises a financial institution account (Nichtberger: the consumer account is managed by the store where the purchase is made and account is settled col. 5 L 19-25).

Claim 4-10: Day or Nichtberger do not clearly recite the financial account as deposit- only account.

Official Notice is taken the applying and recording the credits resulting from use of promotions to a variety of consumer financial accounts (such as a savings or checking account or an account setup by a retailer) are old and well known in the retail transactions process. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the alternative methods of

Art Unit: 3624

applying the savings realized in the retail transaction (i.e. to one or more of a varieties of customer's financial accounts such as those recited in claims 4-10 using different methods) because in this manner a customer would have more choices of applying and managing the credits that he or she deems appropriate as a part of overall personal expense management and record keeping.

Claim 11. The method of claim 1 wherein said presenting promotion choices step comprises presenting specific discounts on specific items (Nichtberger col. 5 L 19-25, ..credits the customer for the coupons the customer has selected..).

Claim 12 and 13. The method of claim 1 wherein said presenting promotion choices step comprises presenting a purchase incentive for one or more items available in said associated store, said purchase incentive unrelated to said one or more items (The coupons presented to the customer (Nichtberger col. 5 L 4-7) incorporate these features because coupons are not just limited to monetary discount on a specific item. Coupons are issued as "buy 2 (item 1) get 1 (another unrelated item 2). Coupons are also offered to buy a specific item at a specific price.). Thus the features claimed herein are inherent in the Nichtberger system.

Claim 14. The method of claim 1 further comprising the step of sending data of said recorded selections to one or more of said associated stores within a preselected time limit after said recording selection step so that said data is sent prior to

Art Unit: 3624

purchase of items by said consumer at said associated store (Nichtberger: since the checkout system 18 automatically credits the customer for the coupons as recited in col. 5 L 17-25 this feature is inherent in the reference).

Claim 15. The method of claim 14 further comprising the step of indicating discounts credited to said consumer account at the time of purchase of items by said consumer at said associated store (Nichtberger col. 11 L 35-45).

Claim 16. The method of claim 15 further comprising the step of invalidating said sent data of said recorded selections to one or more of said associated stores within a preselected time limit after said time of purchase of items by said consumer at said associated store (Nichtberger col. 18 L 10-15).

Claims 17: Day teaches a method for offering targeted incentives to consumers (abstract) comprising inferring a likely store (Day col. 4 L 49-54).

Claim 18. The method of claim 17 wherein said inferring step comprises inferring said likely associated store from the data of previously purchased items by said consumer (Day et al. Col. 7 L 42-50).

Claim 19. The method of claim 17 wherein said inferring step comprises inferring said likely associated store from said unique key (Day et al col.7 L 38-42).

Art Unit: 3624

Claim 20. The method of claim 14 wherein said one or more associated stores are preselected by said consumer (Day et al. Col.7 L 38-42).

Claim 21. The method of claim 1 further comprising the step of sending data of said recorded selections to said associated store upon purchase of items by said consumer at said associated store so that discounts credited to said consumer account are indicated at the time of purchase of items by said consumer at said associated store (Nichtberger col. 17 L 49-56).

Claim 22. The method of claim 1 wherein said receiving data of purchased items step occurs upon purchase of items by said consumer at said associated store (data of purchase items are " products actually being purchased Nichtberger col 17 L 52-55 see also L 62-66).

Claim 23. The method of claim 1 wherein said receiving data of purchased items step occurs within a preselected time limit after purchase of items by said consumer at said associated store (Day et al. Col. 5 L 35-36).

All other elements of the above claims are analyzed in claim 1.

Claim 34-36 : Day or Nichtberger do not clearly teach that the access permitting step over the Internet , and through a Web site operated by the store.

Art Unit: 3624

Official Notice is taken that use of the Internet for product promotions through store Web sites is old and well known.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the access of the promotional system recited by the reference on the Internet through the WWW as recited in claims 34-36 (and claims 53-56) because the merchants would reach large number of customers at minimal cost who can participate in the promotional program.

All other limitations of the subject claims are analyzed in claim 1.

Claim 37: offering targeted promotions to the customers comprising the step of offering promotions to targeted individual consumers derived from received data of consumer purchases (Day col. 3 L 57- col 4 L 9).

All other limitation of claim 37 are analyzed in claim 1.

Claim 38: The method of claim 37 wherein said promotion offering step comprises targeting large aggregates of consumers (Day Col. 3 L 57-col 4 L 9).

Claim 39: The method of claim 37 wherein said promotion offering step comprises targeting individual consumers (Day et al. col 4 L 9).

Claim 40 : The method of claim 39 wherein said targeting step comprises inferring said individual consumers

Art Unit: 3624

from purchasing and promotion selection data of said consumers (Day et al. Col. 4 L 10-24).

Claim 41: All limitations of claim 41 are analyzed in claims 12 and 40.

8. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Day and Nichtberger and further in view of Deaton et al. ('322) (Deaton).

Regarding claims 24,25: Day or Nichtberger do not incorporate the step of presenting data of previously purchased items by said consumer over said communication network to said consumer , however Deaton teaches and claims as invention (col. 149 claims 1-3) this step. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to display previously purchased items by said consumer because this serves as added incentive along with the matching promotion so as to maintain a brand loyalty.

9. Claims 59-76,80-82 and 84-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Day and further in view of Nichtberger.

Claim 59: Day recites method for distributing and redeeming electronic promotions to a plurality of consumers through a communications network, comprising:

Maintaining an account for each consumer, said account having a limited direct identification of said consumer with

Art Unit: 3624

said account to exclude identification of said consumer by name (customer account for each customer are identified by card 22 which contain UPC Codes, col. 5 L 10-29, members of a household can be treated as a single customer...all have cards associating them with same customer account, col. 6 L 58-62);

associating each consumer account with a unique key (see discussion of maintaining step);

permitting access to said consumer account upon presentation of said unique key over said communications network (means for accessing information about the special offers available to the customer associated with the card, col. 5 L 25-29);

accepting offered promotions over said telecommunication network of an item for presentations to consumers wherein the offered promotions are from a promoter of the item (col. 7 L 14-26, computer 16 communicate with manufacturers...).

presenting promotion choices of items available at least one store associated with said unique key over said communications network (refer to: special offers available to the customer...sends a list of special offers to offer communicator 32, col. 5 L 28-33) ;

receiving data of purchased items are received at said associated store (col. 6 L 13-49, data of purchased items are received at the check-out 34 as discussed).

Day invention does not teach the recording selections of promotional choices AND reconciling said selections and purchases to credit said consumer made by consumer as claimed.

Art Unit: 3624

In the same field of endeavor, however, Nichtberger teaches a method of distributing and redeeming and clearing electronic promotions. Nichtberger teaches:

recording selections of said promotion choices made by said consumer over said communications network (col. 5 L 11-15, customer then selects the coupons which he or she wishes to redeem);

reconciling said selections and purchases to credit said consumer (col. 5 L 17-25, the attendant causes the card to be read..the checkout system then automatically credit the consumer for the coupons the consumer has selected).

It would have been obvious to ordinary skill in the art at the time of the invention modify Day so that the consumer is enabled to makes selections of the promotions from the presented promotion choices, and subsequently reconciling the selections against the purchases made by the consumer as per Nichtberger because the combined method would be more convenient to the consumer as she would have to carry any list of special offers while shopping as the consumer has already pre-selected those promotions available to her and would be assured that he or she will be automatically credited for if corresponding items are purchased.

Please refer to analysis of claim 1 for new limitations pertaining to maintaining the consumer account.

Art Unit: 3624

Claims 80-82 are similarly analyzed as 29-31 since they further limit the financial institutional account.

Claim 60 and 61. Accepting offered promotion step further includes at least one criterion for item and offering ..through GUI (..particular targeted offer, Day, col. 7 L 13-26, GUI inherent).

Claim 62. wherein said presenting promotion choices step comprises presenting specific discounts on specific items (Nichtberger col. 5 L 19-25).

Claim 63 and 64. wherein said presenting promotion choices step comprises presenting a purchase incentive for one or more items available in said associated store, said purchase incentive unrelated to said one or more items (The coupons presented to the customer (Nichtberger, col. 5 L 4-7) incorporate these features because coupons are not just limited to monetary discount on a specific item. Coupons are issued as "buy 2 (item 1) get 1 (another unrelated item 2). Coupons are also offered to buy a specific item at a specific price.). Thus the features claimed herein are inherent in the Nichtberger system.

Claim 65. further comprising the step of sending data of said recorded selections to one or more of said associated stores within a preselected time limit after said recording selection step so that said data is sent prior to purchase of items by said consumer at said associated store (Nichtberger,

Art Unit: 3624

since the checkout system 18 automatically credits the customer for the coupons as recited in col. 5 L 17-25 this feature is inherent in the reference).

Claim 66. further comprising the step of indicating discounts credited to said consumer account at the time of purchase of items by said consumer at said associated store (Day col. 6 L 30-34).

Claim 67. further comprising the step of invalidating said sent data of said recorded selections to one or more of said associated stores within a pre-selected time limit after said time of purchase of items by said consumer at said associated store (Nichtberger col. 18 L 10-15).

Claims 68: Day teaches a method for offering targeted incentives to consumers (abstract) comprising inferring a likely store, col. 4 L 49-54).

Claim 69. wherein said inferring step comprises inferring said likely associated store from the data of previously purchased items by said consumer (Day et al. Col. 7 L 42-50).

Claim 70. wherein said inferring step comprises inferring said likely associated store from said unique key (Day et al col.7 L 38-42).

Art Unit: 3624

Claim 71. wherein said one or more associated stores are pre-selected by said consumer (Day et al. Col.7 L 38-42).

Claim 72. further comprising the step of sending data of said recorded selections to said associated store upon purchase of items by said consumer at said associated store so that discounts credited to said consumer account are indicated at the time of purchase of items by said consumer at said associated store (Nichtberger, col. 17 L 49-56).

Claim 73. wherein said receiving data of purchased items step occurs upon purchase of items by said consumer at said associated store (Nichtberger data of purchase items are " products actually being purchased col 17 L 52-55 see also L 62-66).

Claim 74. wherein said receiving data of purchased items step occurs within a preselected time limit after purchase of items by said consumer at said associated store (Day et al. Col. 5 L 35-36).

Claim 85: offering promotions to targeted individual consumers derived from received data of consumer purchases (Day col. 3 L 57- col. 4 L 9).

Claim 86: wherein said promotion offering step comprises targeting large aggregates of consumers (Day et al. Col. 3 L 57- col 4 L 9).

Claim 87: wherein said promotion offering step comprises targeting individual consumers (Day et al. col 4 L 9).

Art Unit: 3624

Claim 88: wherein said targeting step comprises inferring said individual consumers from purchasing and promotion selection data of said consumers (Deaton et al. Col. 4 L 10-24).

Claim 89: All limitations of claim 89 are analyzed as per claim 41.

10. Claims 75 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Day and Nichtberger and further in view of Deaton et al. ('322) (Deaton)

Regarding claims 75,76: Day or Nichtberger do not incorporate the step of presenting data of previously purchased items by said consumer over said communication network to said consumer , however Deaton teaches and claims as invention (col. 149 claims 1-3) this step. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to display previously purchased items by said consumer because this serves as added incentive along with the matching promotion so as to maintain a brand loyalty.

Conclusion

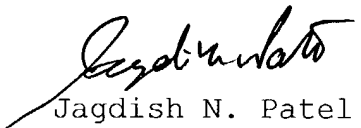
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

7/11/04